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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,660	01/14/2004	Markus Allemann	0212.66402	4465

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EXAMINER

GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/757,660	Applicant(s) ALLEMANN ET AL.	
	Examiner Eric A. Gates	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed on 11 May 2006.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the light touch switch being located substantially within the housing as cited in claim 1 and the switch being a part of the tool and located substantially within the housing thereof as cited in claim 10 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 includes the limitation "...said control mechanism being a part of the tool and located substantially within the housing thereof and comprising: ... a light touch switch...", and claim 10 includes the limitation "said switch being a part of the tool and located substantially within the housing thereof". As described in the specification, light touch switch 30 is disposed on a portion of nose portion 12 and therefore is not located substantially within the housing.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sjostrom (U.S. Patent 5,712,543).

7. Regarding claim 1, Sjostrom discloses a control mechanism 135/145 (portion of cable 145 within housing 105 as seen in figure 2) for a rotary hand tool 100 having a generally cylindrical housing 105 in which a drive motor 120 is located, the housing having a nose portion (not labeled, left side in figure 1) at an end from which a motor output shaft 115 extends (see figure 2, shaft extends (primary definition "to stretch out", per Oxford online dictionary) from motor in nose portion) and a grip portion 655 around which an operator can wrap a hand during operation of the tool and within which portion the motor is housed, said control mechanism being a part of the tool and located substantially within the housing thereof and comprising: an electrical control circuit 145 that controls the application of power to and the operation of the motor (with processor 215), including supplying current to the motor; and a light touch switch 135 (said light touch switch 135 is located "substantially within the housing" in a manner similar to that currently disclosed in the instant application) having at least a first position (not pushed) and a second position (pushed) (see column 1, lines 25-27) coupled to said electrical control circuit for selectively enabling or disabling said control circuit to turn the motor on and off (see column 4, lines 64-65), wherein said motor current does not flow through said switch (see column 4, lines 41-45); wherein said switch is disposed on a portion of

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the nose portion of the rotary hand tool such that an operator can actuate said switch without altering the operator's grip on the tool.

8. Regarding claim 3, Sjostrom discloses wherein said switch has a predetermined thickness (identically sized per column 4, line 50).

9. Regarding claim 4, Sjostrom discloses wherein said first position disables said electrical control circuit and said second position enables said electrical control circuit (see column 4, lines 64-65).

10. Regarding claim 5, Sjostrom discloses wherein said portion of the nose portion on which said switch is disposed generally corresponds to a location of the operator's index finger when grasping the tool (see figure 1).

11. Claims 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sjostrom (U.S. Patent 5,712,543).

12. Regarding claim 10, Sjostrom discloses an apparatus 200 for selectively controlling power applied to and the operation of the motor 120 of a rotary hand tool 100 having a generally cylindrical housing 105 that includes a generally cylindrical nose portion (not labeled, left side in figure 1) at an end from which an output shaft extends (see figure 2, shaft extends (primary definition "to stretch out", per Oxford online dictionary), and a grip portion 655 around which an operator wraps a hand during operation of the tool, said apparatus comprising: electrical control circuitry 145 (portion of cable 145 within housing 105 as seen in figure 2) for controlling power, including motor current that is applied to the motor 120, said electrical circuitry being a part of the

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tool and located substantially within the housing; a switch 135 having a switch button 135 and containing at least a pair of switch contacts (see column 1, lines 25-27) that are selectively opened and closed responsive to actuation of said switch button, said switch being operatively connected to said control circuitry to control the operation of the motor, including the application of motor current to the motor (see column 4, lines 64-65), said switch being configured so that said motor current does not pass through the switch contacts during operation of the motor (see column 4, lines 41-45), said switch being a part of the tool and located substantially within the housing thereof (said switch 135 is located "substantially within the housing" in a manner similar to that currently disclosed in the instant application); and a cavity 175 disposed in the nose portion of the tool that is configured to receive at least a portion of said switch and permit actuation of said switch button.

13. Regarding claim 12, Sjostrom discloses that the outer surface of said switch button 135 is generally coextensive with the outer surface of said nose portion.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjostrom in view of Markle et al. (U.S. Patent 4,772,765).

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16. Regarding claim 2, Sjostrom discloses the invention substantially as claimed, except Sjostrom does not disclose wherein said switch is configured to be generally rectangular.

Markle et al. teaches the use of a rectangular switch 28 for the purpose of allowing for sliding the switch along a right and left path using one finger. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Sjostrom with the rectangular switch of Markle et al. in order to have a tool with a switch which may be slid to the left and right using one finger.

17. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjostrom in view of Von Hollen (U.S. Patent 3,640,635).

18. Regarding claim 6, Sjostrom discloses the invention substantially as claimed, except Sjostrom does not disclose a layer of flexible grip material surrounding at least a portion of the nose portion.

Von Hollen teaches the use of a layer of rubber 11 surrounding the portion of the nose portion in which a switch 55-49 is disposed, abutting said switch when the flexible material is compressed, for the purpose of providing a yielding surface in the nose portion of the tool. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Sjostrom with the flexible grip material of Von Hollen in order to have a tool with a more comfortable grip.

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19. Regarding claims 7-9, the modified invention of Sjostrom discloses the invention substantially as claimed.

20. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjostrom in view of Von Hollen (U.S. Patent 3,640,635).

21. Regarding claim 11, Sjostrom discloses the invention substantially as claimed, except Sjostrom does not disclose a layer of grip material surrounding at least a portion of the grip portion in which said switch is located.

Von Hollen teaches the use of a layer of rubber 11 surrounding the portion of the nose portion in which a switch 55-49 is disposed, abutting said switch when the flexible material is compressed, for the purpose of providing a yielding surface in the grip portion of the tool. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Sjostrom with the flexible grip material of Von Hollen in order to have a tool with a more comfortable grip.

Response to Amendment

22. The amendment filed 11 May 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the light touch switch being "located substantially within the housing", as cited in claim 1, and "said

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switch being a part of the tool and located substantially within the housing thereof", as cited in claim 10, is not supported by the original specification. Page 4, lines 20-22, states that "the preferred embodiment of the instant invention contemplates an improved control system for the tool 10 that includes a light touch switch 30 disposed on a portion of the nose portion 12". As shown in figure 1, light touch switch 30 includes a portion of the housing, and as such is not located substantially within the housing.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

23. Applicant's arguments filed 11 May 2006 have been fully considered but they are not persuasive.

24. Applicant's argument that Sjostrom is unrelated art is not persuasive because the limitations relied upon in the Sjostrom patent relate to the art of rotary hand tools as disclosed by Sjostrom and as claimed in the instant application. The fact that the Sjostrom patent utilizes technology that is more complicated than the instant application is moot because the Sjostrom invention reads on the claims as described in the rejections above.

25. Applicant's arguments with respect to the amended material in claims 1 and 10 have been considered but are moot in view of the new ground(s) of rejection.

26. In response to applicant's argument that there is no suggestion to combine the references in the rejections of claims 2, 6-9, and 11, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the

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prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the motivation to combine the references in the rejection of claim 2 is found in the art itself (see column 6, lines 52-56 of Markle et al. '765). The motivation to combine the references in the rejection of claims 6-9 and 11 is also found in the art (see column 3, lines 15-19 of Von Hollen '635).

27. For the reasons as set forth above, the rejections are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
29 August 2006



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SUPERVISORY PATENT EXAMINER